

Remarks

The present amendment is in response to the Office action dated December 21, 2006, rejecting claims 42-53. Claims 42 – 53 remain pending in the present application, with claims 42 and 48 being the independent claims. Claim 54 is new. Accordingly, claims 42-54 are pending in the present application with claims 42, 48, and 54 being the independent claims. Reconsideration and allowance of pending claims 42-54 in view of the following remarks are respectfully requested.

A. Amendments to the Specification

The Office Action objected to the title of the invention stating that it is not descriptive so as to help one having ordinary skill in the art to understand the nature of the subject matter. Applicant respectfully submits that it has obviated the rejection by presenting a new title of the invention and that the new title of the invention is descriptive.

B. Rejection of Claims Under 35 USC § 112

In the Office Action, Claims 42-53 are rejected under 35 U.S.C. §112 for failing to comply with the written description requirement. The Office Action states that “the specification does not expressly support a merge module configured to create an identified event on the calendar (schedule) of events and a reference providing network access to the scheduling module (calendar) or the step of merging a personalized message with a reference providing network access to a scheduling module (calendar).

Applicant directs the Examiner to its 15 August 2005 reply that compares claims 42 and 48 to the claims as originally filed and demonstrates that the merge module was present in the application as originally filed and also demonstrates that including a reference providing network access to the scheduling module (claim 16) was present in the original disclosure. Applicant further directs the Examiner to Figures 2, 4, and 5 and their respective descriptions that each expressly disclose and describe the claimed merge module and claims 2 and 7 and their respective descriptions that each expressly disclose and describe the claimed schedule module. The Examiner’s rejection appears to be based on something other than a careful reading of Applicant’s disclosure.

C. Intended Use

The Office Action states that claims 42 and 48 are based on “intended use” recitations. Applicant objects to this separate characterization of the pending claims under the “General Comments” heading. According to MPEP § 2111.02:

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. (citations omitted). If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (anticipation rejection affirmed based on Board's factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable of dispensing popcorn in the manner set forth in appellant's claim 1 (a dispensing top for dispensing popcorn in a specified manner)) and cases cited therein. See also MPEP § 2112 - § 2112.02.

Thus, if the Examiner is asserting that the preambles of the pending independent claims serve as additional limitations to the claims, Applicant requests that the Examiner state that this is the case. Furthermore, if this is how the Examiner is interpreting the claims, Applicant requests that the Examiner properly address these additional limitations (if appropriate) in any 102 or 103 rejections so that the explanation as to how the prior art discloses these additional limitations can be appropriately responded to. Finally, Applicant points out that the “capability” test only applies to those limitations that are found in the preamble and objects to the Examiner’s use of this test for the claimed structure and steps in independent claims 42 and 48.

D. Rejection of Claims Under 35 USC § 102

In the Office Action, Claims 42, 44-45, 48, and 50-51 are rejected under 35 U.S.C. 102(b) as being unpatentable over Plainfield. Applicant respectfully submits that Plainfield does not teach every element of the claims as set forth in the pending independent claims and further points out that the Office Action fails to identify any disclosure in Plainfield that describes or even suggests that a personalized message include a reference providing network access to the scheduling module as required by independent system claim 42. Similarly, the Office Action fails to identify any

disclosure in Plainfield that describes or even suggests that a personalized message is merged with a reference providing network access to a scheduling module that manages a schedule of events for the service provider, as required by independent method claim 48. Accordingly, the independent claims and their respective dependent claims are presently in condition for allowance.

Furthermore, the claims are directed toward a computer implemented system for marketing the services of a service provider over a computer network. The claimed system requires a database of client profiles where each client profile includes a network address for the client. The claimed system also requires a scheduling module that is configured to manage a schedule of events for the service provider and identify an event on the service provider's schedule of events that pertains to a first client. The claimed system also requires a merge module that is configured to create a personalized promotion addressed to the first client at the first client's network contact address. The personalized promotion is required to include a personalized message, the identified event that pertains to the first client, and a reference providing network access to the scheduling module. The claimed system also requires a communication module that sends the personalized promotion to the first client via a communication network.

Plainfield does not teach the claim elements. Specifically, Plainfield lacks any teaching or disclosure related to a service provider's schedule of events or providing a client with access to that schedule of events via reference in a personalized promotion that provides network access to the scheduling module. Plainfield teaches an interactive data entry system that entices customers or potential customers to input data about themselves for storage in a customer database. Plainfield teaches that promotional messages may be generated by the system and sent to the customers. Plainfield does not teach a scheduling module configured to manage a schedule of events for a service provider and Plainfield also does not teach that a personalized promotion includes a reference that provides network access to the scheduling module, as required by independent claims 42 and 48. Accordingly, Applicant respectfully submits that independent claims 42 and 48 are presently in condition for allowance. Furthermore, because the dependent claims further refine the inventions in the base claims, Applicant respectfully submits that the dependent claims are also in condition for allowance and a notice of allowance for all pending claims is respectfully requested.

E. Rejection of Claims Under 35 USC § 103

In the Office Action, Claims 43 and 49, 46-47, and 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plainfield. The Office Action states that Plainfield does not expressly disclose generating a holiday greeting, an appointment, or a prescription number but that public disclosures make this limitation obvious. This rejection is traversed as follows.

A claim is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a prima facie case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Modify

In the Office Action, no motivation has been supplied for modifying Plainfield. The subject matter of the present claims is related to a computer implemented system for marketing the services of a service provider over a computer network. The Examiner states that Plainfield teaches such a system, except Plainfield does not disclose generating a holiday greeting, an appointment, or a prescription reminder. The Examiner further states that such a limitation is common practice, but no citation to a reference disclosing such common practice is identified.

There are very significant differences, however, between a holiday, birthday, and anniversary greetings, appointment reminders, and prescription reminders and a computer implemented system for marketing the services of a service provider over a computer network. Merely because a service provider sends out a holiday greeting for example, they would not be motivated to do so over a computer network, nor would they be motivated to provide a "reference that provides network access to a scheduling module," since such a reference takes place inside of a computer and merely sending a holiday card does not.

Furthermore, while sending holiday greetings may be commonplace, sending an appointment reminder and a prescription reminder is not. Specifically, the computer implemented system must first obtain the information about when the appointment is schedule in order to send out an appropriate reminder. Even more significantly different is a prescription reminder, which requires the computer implemented system to have information about the prescription, the prescribed usage, and the calculated consumption date for the prescription such that the prescription reminder can be sent at the appropriate time. Therefore, Plainfield in view of the official notice does not create a suggestion or a motivation to achieve the present claims.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited reference points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. For example, Applicant claims a “reference that provides network access to a scheduling module.” Such a reference provides for a computer to automatically send out the promotion when the event occurs. A “holiday greeting, an appointment, or a prescription reminder” does not perform automatic notification as the computerized reference presently claimed. As such, merely receiving notice would be ineffective and not work because as a result of the notice, no action occurs, no reminder is sent, and the recipient receives nothing. Therefore, Plainfield in view of the official notice could not be reasonably expected to succeed.

Furthermore, the Examiner has provided no citation that identifies a reasonable expectation of success in sending an appointment reminder or a prescription reminder is not. Specifically, the Examiner has cited no disclosure in Plainfield teaching that information about when an appointment is scheduled is first obtained in order to send out an appropriate reminder. Even more deficient is the lack of any disclosure in Plainfield teaching that information about the prescription, the prescribed usage, and the calculated consumption date for the prescription such that the prescription reminder can be sent at the appropriate time. Therefore, Plainfield in view of the official notice could not be reasonably expected to succeed.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. In particular, the claims are directed toward a computer implemented system for marketing the services of a service provider over a computer network. The claimed system requires a database of client profiles where each client profile includes a network address for the client. The claimed system also requires a scheduling module that is configured to manage a schedule of events for the service provider and identify an event on the service provider's schedule of events that pertains to a first client. The claimed system also requires a merge module that is configured to create a personalized promotion addressed to the first client at the first client's network contact address. The personalized promotion is required to include a personalized message, the identified event that pertains to the first client, and a reference providing network access to the scheduling module. The claimed system also requires a communication module that sends the personalized promotion to the first client via a communication network.

Plainfield does not teach the claim elements. For at least the reasons discussed with respect to the independent claims 42 and 48 in the rejection under 35 U.S.C. § 102 and above, the independent claims are in a condition for allowance. Claims 43-47 and 49-53 are in a condition for allowance as well. Accordingly, since the combination of references does not include all the limitations of claims of the independent claims 42 and 48 and their respective dependent claims, the Applicant requests that the rejection be withdrawn.

Conclusion

Pursuant to the remarks set forth in this response, Applicant respectfully asserts that all pending claims are presently in condition for allowance and a notice of allowance for claims 42 – 53 and new claim 54 is respectfully requested.

Respectfully submitted,
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